

Application No. 10/786,329
Amendment dated November 7, 2005
After Final Office Action of August 5, 2005

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REMARKS

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant wishes to thank Examiner Palabrica for holding a telephone interview with the attorney of record on November 7, 2005. The present amendment to the claims was discussed and the Examiner indicated that upon initial review the claims appeared to be in proper form, free of objectionable intended use. Also, the attorney of record stressed that the presently claimed invention was an improvement over the cited Martin references that are commonly assigned to the present assignee. No agreement was reached but the Examiner indicated he would review the amendment in detail as a result of the interview. The following comments summarize the interview discussion.

The Office Action and prior art relied upon have been carefully considered.

Previous claims 15-24 were rejected under 35 U.S.C. § 112 second paragraph as indefinite. The accompanying amendment to the claims rectifies the objectionable language pointed out by the Examiner so that further rejection on this ground is not anticipated.

Claims 16-21 were rejected under 35 U.S.C. § 102 (a) as anticipated by either Martin reference (US 4,782,727 and 4,847,038).

Claims 22 and 23 were rejected under 35 U.S.C. § 102(a) as anticipated by Marin et al (US 4,782,727).

In an effort to expedite the prosecution previous independent claim 15 has been cancelled and rewritten as claim 25. This claim sets forth the inventive apparatus as proper means plus function language.

The present invention prepares the ends of a replacement pipe for welding as does the cited Martin patents. However, as set forth in claim 25 the invention additionally provides means located in the pipe for working along the entire length of the interior surface to the primary pipe; and also includes means for introducing the working means into the welded replacement pipe section. The later inclusion responds to the Examiner's argument stated in Paragraph 2 of the

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Office Action. The references neither include such additional working means nor introducing means.

The chamfering and welding devices of Martin and Martin et al are introduced into the pipe through the free space left by the portion of the pipe that was cut and removed, before the new portion of pipe is put in place. It is clearly indicated in Martin (column 10, line 64-66 and in figures 17 and 18) "that a welding chamfer is machined on the end of the pipes 3 and 5 using a chamfering machine of the orbital type, such as shown in FIGS 17 and 18...". The end of pipes 3 and 5 shown in figures 17 and 18 are free ends, and it is clear from the figures that the chamfering machine is introduced inside the pipe before the new pipe is welded in place. It is also clear when comparing figures 2 and 4B of Martin et al, that the chamfering machine is introduced through the space left by the section of pipe that is removed. There are no working means which are able to move along the interior length of the primary pipe from the first component to said second components to the new replacement section welded to the remaining pipes of the primary circuit in Martin and Martin et al.

It must be underlined as well that the welding and chamfering machines of Martin and Martin et al are adapted only for being introduced through the space left by the portion of pipe previously cut, before the new portion is put in place. These machines are not adapted for moving along the primary pipe from one of the first or second component to the new replacement section welded to the remaining pipes of the primary circuit. For moving along the primary pipe in such a way, said machines would need to be mounted to some sort of carriage including means to propel itself along the pipe. Neither Martin nor Martin et al discloses such a carriage.

With regard to claim 21, the Examiner asserts that the chamfering machine of Martin and the TIG orbital welding machine of Martin et al are adapted to be used for machining the inner part of the joined welded ends of the new replacement section and of the remaining parts of the primary pipe. However, the chamfering machine depicted in figures 17 and 18 of Martin is clearly not adapted to be used in this way. It is adapted to machine the edge of a free end of the pipe (see the position of the machining head in figure 17). It cannot be used inside a pipe,

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because part 91 has a length which is larger than the internal diameter of the pipe to be machined such that the machine cannot be introduced wholly into the pipe. Furthermore, the working position of the machining head is unsuitable for working on the inner surface of the pipe.

Furthermore, to be able to use the chamfering machine of Martin inside a pipe, after the new replacement section has been welded, it is necessary to have means to introduce the chamfering machine into the primary pipe through a pre-existing opening which is necessarily at a distance from the section to be chamfered, and to have means to move the chamfering machine from said opening to said section to be chamfered. Martin does not disclose such means, and there are no indications in Martin that the chamfering machine is adapted to be introduced and moved along the primary pipe in the way described above.

Similar remarks can be made regarding the TIG orbital welding machine of Martin et al. It is a highly sophisticated, special purpose machine, adapted for automated orbital welding of a given replacement section on a primary pipe in a highly radioactive environment. The welding machine is disposed outside the primary pipe. Such machines are designed for a given geometry and a given environment and must be transformed to work in different conditions. They are not adapted for the invention as set forth in claim 21.

Anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims. *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986). There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102. *Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991); *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (Fed. Cir. 1984).

In view of the above, consideration and allowance are, therefore, respectfully solicited.

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In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Director is hereby authorized to charge any fees, or credit any overpayment, associated with this communication, including any extension fees, to CBLH Deposit Account No. 22-0185, under Order No. 20513-00590-US1 from which the undersigned is authorized to draw.

Dated: November 7, 2005

Respectfully submitted,

By 

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